Image

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CERTIFICATE OF MAILING

I hereby certify that this correspondence (along with any paper referred to as being attached or enclosed) is being deposited with the United States Postal Service on the date shown below with sufficient postage as first class mail in an envelope addressed to: Mail Stop Appeal Brief, Commissioner for Patents, P.O. Box 1450, Alexandria, Virginia 22313 - 1450

Date: 12-18-03

Himanshu S. Amin

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re patent application of:	
Applicant(s): Nainesh P. Shah	Examiner: Daniel St Cyr
Serial No: 10/017,655	Art Unit: 2876
Filing Date: December 6, 2001	

Title: GOOD READ INDICATOR FOR HYBRID CODE READER

Mail Stop Appeal Brief-Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, Virginia 22313-1450

APPEAL BRIEF

Dear Sir:

Applicant's representative submits this brief in triplicate in connection with an appeal for the above-identified application. Please charge the requisite fee associated with this brief to Deposit Account No. 50-1063 (Reference Number TELNP217USA).

12/29/2003 AWONDAF1 00000104 501063 10017655
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I. Real Party in Interest (37 C.F.R. § 1.192(c)(1))

The real party in interest in the present appeal is SYMBOL TECHNOLOGIES INC. *via* assignment from TELXON CORPORATION; the initial assignee of the present application.

II. Related Appeals and Interferences (37 C.F.R. § 1.192(c)(2))

Appellant, appellant's legal representatives, and/or the assignee of the present application are unaware of any appeals or interferences that will directly affect, or be directly affected by or have a bearing on the Board's decision in the pending appeal.

III. Status of Claims (37 C.F.R. § 1.192(c)(3))

Claims 1-10 and 12-22 are pending in the application. The rejection of claims 1-10 and 12-22 is appealed.

IV. Status of Amendments (37 C.F.R. § 1.192(c)(4))

No amendments have been filed subsequent to final rejection.

V. Summary of Invention (37 C.F.R. § 1.192(c)(5))

Applicant's claimed invention, filed after November 29, 1999, relates to an image collecting module that reads one-dimensional, two-dimensional and hybrid dataforms, and a switch for determining which type of dataform to be read. Such module is also equipped with an indicator system and method for providing a user with indication of a valid read, or an invalid read.

When a hybrid dataform is to be read, the image collecting module employs a first indicator that verifies a valid read for a first portion of the hybrid dataform (*e.g.*, the one-dimensional portion or the two-dimensional portion), and a second indicator for indicating a valid read for a second portion (*e.g.*, the other of the one-dimensional portion or the two-dimensional portion). The first and second indicators may be visual, audible, mechanical (*e.g.*, vibration) or a combination of the above. Error indicators are also provided for indicating an invalid read for the first and/or the second portions of the hybrid dataform.

VI. Statement of the Issues (37 C.F.R. § 1.192(c)(6))

Whether the references of Li *et al.* (U.S. Patent 5,672,858) and Giordano *et al.* (U.S. Patent 6,321,990) are citable prior art references to support a 35 U.S.C. §103(a) rejection of claims 1-10 and 12-22.

VII. Grouping of Claims (37 C.F.R. § 1.192(c)(7))

For the purpose of this appeal only, all claims of the subject application stand or fall together.

VIII. Argument (37 C.F.R. § 1.192(c)(8))

Rejection of Claims 1-10 and 12-22 Under 35 U.S.C. §103(a)

Claims 1-10 and 12-22 stand rejected under 35 U.S.C. §103(a) as being obvious over Li *et al.* (U.S. Patent 5,672,858) in view of Giordano *et al.* (U.S. Patent 6,321,990). A reversal of the rejection is respectfully requested for at least the following reasons.

i. Such obviousness type rejection is improper because 35 U.S.C. §103(c) prevents citing against the present application, any patent that is commonly owned by, or was subject to an obligation of assignment to Symbol Technologies Inc., at the time the invention was made.

> "Under a 1999 amendment to 35 U.S.C § 103(c), subject matter which qualifies as prior art only under section 102(e) cannot preclude patentability under 103 where the subject matter and the claimed invention were, at the time the invention was made owned by the same person or subject to an obligation of assignment to the same person [...] the amendment to section 103(c) only affect patents filed on or after November 29, 1999 effective date. *Riverwood International Corp. v. R.A. Jones & Co.*, 324 F.3d, 1346, 1356 n.2, 66 USPQ2d 1331 (Fed. Cir. 2003)

The cited references of Li *et al.* and Giordano *et al.*, as well as the present application are commonly owned by, or were subject to an obligation of assignment to Symbol Technologies, Inc., at the time of the invention. Accordingly, 35 U.S.C. §103(c) excludes such commonly owned prior patents to be cited as references under an

obviousness type 35 U.S.C. §103(a) rejection against the subject application, which is filed after November 29, 1999.

For at least the above reasons Li *et al.* and Giordano *et al.*, are not citable references against the subject claims, and this rejection should be withdrawn. In addition, it is respectfully submitted that applicant's representative is willing to execute a terminal disclaimer to the extent required, and disclaim a term beyond the commonly owned cited references of Li *et al.* and Giordano *et al.*

IX. CONCLUSION

For at least the above reasons, the claims currently under consideration are believed to be patentable over the cited references. Accordingly, it is respectfully submitted that the rejections of claims 1-10 and 12-22 be reversed.

Respectfully submitted,

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X. Appendix of Claims (37 C.F.R. § 1.192(c)(9))

1. An image collecting module, comprising:

a first multicolor photo indicator to provide an indication of a valid read of a first portion of a hybrid dataform; and

a second indicator to provide an indication of a valid read of a second portion of the hybrid dataform.

2. The module of claim 1, further comprising a processor to provide activation of the first multicolor photo indicator and the second indicator upon a valid read of the respective portions of the dataform.

3. The module of claim 1, the first multicolor photo indicator being a first LED and the second indicator being a second LED.

4. The module of claim 3, the first LED flashing a first color upon a valid read of the first portion and flashing a second color upon an invalid read of the first portion, and the second LED flashing the first color upon a valid read of the second portion and flashing the second color upon an invalid read of the second portion.

5. The module of claim 3, the first LED illuminating upon a valid read of the first portion, and the second LED flashing and the first LED turning off upon a valid read of the second portion.

6. The module of claim 1, the first multicolor photo indicator being an on state of a LED and the second indicator being an off state of the LED wherein the LED illuminates upon a valid read of the first portion and remains on until a valid read of the second portion.

7. The module of claim 6, the LED flashing red for an invalid read of one of the first portion and the second portion.

8. The module of claim 1, the first multicolor photo indicator being a first LED signal and the second indicator being a first audible signal.

9. The module of claim 8, further comprising a second audible indicator generating a second audible signal, the first audible signal having a different tone than the second audible signal.

10. The module of claim 1, the second indicator being an audible indicator representative of an on state of an audible system and the second indicator being an audible signal of an off state of the audible system, wherein the audible system stays on upon the valid read of the first portion and remains on until the valid read of the second portion.

12. The module of claim 1, further comprising a selection switch for selecting between reading dataforms of a one-dimensional type, a two-dimensional type and a hybrid type.

13. A method of providing indication of a valid read by an image collecting module, comprising:

reading in a first portion of a hybrid dataform;

determining if the first portion is valid;

reading in a second portion of the hybrid dataform;

determining if the second portion is valid; and

providing the indication in the form of a photo signal if the first and second portion are valid.

14. The method of claim 13, wherein providing the indication if the first and second portion are valid comprises providing a first indication if the first portion is valid and providing a second indication if the second portion is valid.

15. The method of claim 14, wherein providing the first indication comprises flashing a first LED for a valid read of the first portion and providing the second indication comprises flashing a second LED for a valid read of the second portion.

16. The method of claim 14, further comprising providing an error indication if an invalid read occurs for one of the first portion and the second portion.

17. The method of claim 14, wherein providing the first indication comprises providing a first audible tone for a valid read of the first portion and providing the second indication comprises providing a second audible tone for a valid read of the second portion.

18. The method of claim 14, wherein providing the first indication comprises activating an audible tone for a valid read of the first portion and providing the second indication comprises deactivating the audible tone for a valid read of the second portion.

19. The method of claim 14, wherein providing the first indication comprises activating a vibration system for a valid read of the first portion and providing the second indication comprises deactivating the vibration system for a valid read of the second portion.

20. An image collecting system, comprising:

means for determining a valid read of a first portion of a hybrid dataform;

means for determining a valid read of a second portion of a hybrid dataform;

means for enabling an illumination indicator if the first portion of the hybrid dataform is valid; and

means for disabling the illumination indicator if the second portion of the hybrid dataform is valid.

21. An image collecting module, comprising:

a vibration system for indicating the read status of a hybrid dataform, the system including;

a first vibration indicator to provide an indication of a valid read of a first portion of the hybrid dataform, the first vibration indicator being an on state of the vibration system; and

a second vibration indicator to provide an indication of a valid read of a second portion of the hybrid dataform, the second vibration indicator being an off state of the vibration system;

wherein the vibration system vibrates upon the valid read of the first portion and remains on until the valid read of the second portion.

22. A portable image collecting module, comprising:

a first indicator to provide an indication of a valid read of a first portion of a hybrid dataform; and

a second indicator to provide an indication of a valid read of a second portion of the hybrid dataform;

wherein the first indicator and the second indicator each in the form of one of an audio signal, a photo signal, and a vibration signal.

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